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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,102	01/31/2002	Cary Lee Bates	END920010052US1	9951

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
2173	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/062,102	BATES ET AL.	
	Examiner	Art Unit	
	Blaine Basom	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In view of the Appeal Brief received on July 23, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claim 23 recites a "system for selecting multiple sets of data in an application," the system comprising a "set selection system" and a "portion selection system." The specification and drawings of the present application suggest that this "set selection system" and "portion selection system" can be software, i.e. part of an application (see e.g. page 8, line 16 – page 9, line 9; and FIG. 1). In such embodiments, the "system" of

claim 23 is program code per se, and fails to fall within a statutory category of invention (i.e. a machine, manufacture, process, or composition of matter). Claims 24-26 are also rejected under 35 U.S.C. 101 for similar reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 6-7, 9, and 13-15 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,240,430 to Deike et al. (hereinafter "Deike"). In general, Deike describes a system in which multiple noncontiguous blocks of text can be selected and manipulated (see e.g. column 1, lines 6-12; and column 2, lines 14-36).

Specifically regarding claim 1, Deike teaches: selecting a first set of data (e.g. a first "block" of text) within an application (see e.g. column 1, lines 24-55; and column 4, lines 21-45); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-45; and FIG. 6). Deike thus teaches a method like that of claim 1, which is for selecting multiple sets of data in an application.

As per claim 2, Deike discloses that the user performs a first predetermined keystroke (e.g. "Alt-S") after selecting a first set of data, wherein the selected keystroke allows the first set of data to remain selected during the selection of a second set of data (see e.g. column 4, lines 21-46).

As per claim 3, Deike discloses that the selected sets of data can be simultaneously copied and pasted to a predetermined area (see e.g. column 1, line 24 – column 2, line 11; and column 4, line 21 – column 5, line 28).

As per claim 6, Deike discloses that the second selected set of data can be non-contiguous with the first selected set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-46; and FIG. 6).

As per claim 7, Deike demonstrates that the data can be text (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-46; and FIG. 6).

With respect to claim 9, Deike teaches: providing an application (e.g. a text editor) for manipulating data (see e.g. column 1, lines 14-42; and column 2, lines 14-36); selecting a first set of data (e.g. a first "block" of text) within the application (see e.g. column 1, lines 24-55; and column 4, lines 21-45); performing a first predetermined keystroke (e.g. "Alt-S") after selecting the first set of data (see e.g. column 4, lines 21-46); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-45; and FIG. 6). Deike thus teaches a method like that of claim 9, which is for selecting multiple sets of data in an application.

As per claim 13, Deike discloses that the second selected set of data can be non-contiguous with the first selected set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-46; and FIG. 6).

As per claim 14, Deike demonstrates that the data can be text (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-46; and FIG. 6).

As per claim 15, Deike suggests that the above-described application (e.g. text editor) can be for writing computer code (e.g. can be a "source code editor") (see column 1, lines 14-24; and column 2, lines 24-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-5 and 10-12, 17-21, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Deike, which is described above, and also over U.S. Patent No. 5,694,610 to Habib et al. (hereinafter "Habib").

Specifically regarding claim 4, Deike teaches a method like that of claim 1, in which a user can select multiple, non-contiguous sets of data in an application, as is described above (see e.g. the rejection for claim 1). Deike, however, does not explicitly disclose that the user can further select, in a distinctive manner, a first portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portion, as is recited in claim 4. Nevertheless, selecting a portion of a selected set of data is known in the art.

For example, Habib demonstrates selecting (e.g. highlighting) a set of data within an application, and then selecting a portion of the selected set of data (i.e. via a "rich text field" within a dialog box displaying the selected set of data), whereby the selected set of data remains selected during the selection of the portion (see e.g. column 6, line 24 – column 7, line 7; and FIGS. 4A-4D).

It would have been obvious to one of ordinary skill in the art, having the teachings of Deike and Habib before him at the time the invention was made, to modify the application taught by Deike to include dialog boxes like taught by Habib, which allow the user to select portions of already-selected sets of data. It would have been advantageous to one of ordinary skill to utilize this combination, because such dialog boxes are common and useful for presenting application functionality for manipulating selected sets of data, as is suggested by Habib (see e.g. column 1,

lines 20-50). Deike and Habib thus teach – to one of ordinary skill in the art – a method like that of claim 4.

As per claim 5, Habib teaches selecting a first portion of a selected set of data (as is described above), but does not explicitly describe selecting a second portion of the selected set of data, wherein the first portion remains selected during selection of the second portion based upon a predetermined keystroke, as is required by claim 5.

Nevertheless, Deike generally teaches selecting multiple non-contiguous sets of data, and specifically asserts that it is desirable to allow the user to do so (see e.g. column 1, line 66 – column 2, line 36). Deike particularly teaches selecting a first set of data, and selecting a second set of data, wherein the first set remains selected during selection of the second set based upon a predetermined keystroke (see e.g. column 4, lines 21-46; and FIG. 6).

That is, it would have been obvious to one of ordinary skill in the art, having the teachings of Deike and Habib before him at the time the invention was made, to further modify the dialog box taught by taught by Deike and Habib, which includes rich text fields that display a selected set of data and allow the user to select and modify portions of the selected set of data, such that the user can select multiple sets (i.e. portions) of the set of data displayed by the dialog box, like taught by Deike. It would have been advantageous to one of ordinary skill to utilize this combination, because the ability to select multiple non-contiguous sets of data can lead to more efficient data manipulation, as is suggested by Deike (see e.g. column 1, line 51 – column 2, line 11). The above-described combination of Deike and Habib thus teach – to one of ordinary skill in the art – a method like that of claim 5.

Regarding claim 10, Deike teaches a method like that of claim 9, in which a user can select multiple, non-contiguous sets of data in an application, as is described above (see e.g. the rejection for claim 9). Deike, however, does not explicitly disclose that the user can further select, in a distinctive manner, a first and second portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portions, as is expressed in claim 10. Nevertheless, as described above (see e.g. the rejections for claim 4 and 5), Habib teaches selecting, in a distinctive manner, a first portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the first portion; and the combination of Habib and Deike teaches performing a predetermined keystroke, and selecting in a distinctive manner a second portion of the one of the selected sets of data, wherein the first portion remains selected during the selection of the second portion based upon the predetermined keystroke. Accordingly, the above-described combination of Deike and Habib teach – to one of ordinary skill in the art – a method like that of claim 10.

As per claims 11-12, Deike discloses that the selected sets of data can be simultaneously copied and pasted to a predetermined area (see e.g. column 1, line 24 – column 2, line 11; and column 4, line 21 – column 5, line 28). Habib further demonstrates that selected portions of such a selected set of text can be e.g. cut, copied, pasted, or edited (see e.g. column 6, line 24 – column 7, line 7; and FIGS. 4A-4D). The user can thereby manipulate (e.g. cut, copy, paste, edit) the selected portions in the predetermined area.

Regarding claim 17-19, Deike teaches: providing an application (e.g. a text editor) for writing computer code (see e.g. column 1, lines 14-42; and column 2, lines 14-36); selecting a first set of data (e.g. a first "block" of text) within the application (see e.g. column 1, lines 24-55; and column 4, lines 21-45); performing a first predetermined keystroke (e.g. "Alt-S") after selecting the first set of data (see e.g. column 4, lines 21-46); and selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-45; and FIG. 6). Habib further teaches selecting, in a distinctive manner, a portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portion, as is described above (see e.g. the rejection for claim 4). Moreover, Deike suggests that the selected sets of data can be simultaneously copied, cut, and then pasted to a predetermined area (see e.g. column 1, line 24 – column 2, line 11; and column 4, line 21 – column 5, line 28). Habib also demonstrates that selected portions of such a selected set of data can be e.g. cut, copied, pasted, or edited (see e.g. column 6, line 24 – column 7, line 7; and FIGS. 4A-4D). It is thereby apparent that the user can manipulate (e.g. cut, copy, paste, edit) the selected portions after they're pasted. Accordingly, the above-described combination of Deike and Habib teach – to one of ordinary skill in the art – a method like that of claims 17-19.

As per claim 20, Deike demonstrates that the data can be text (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-46; and FIG. 6).

Regarding claim 21, Deike teaches: selecting a first set of data and a second set of data (e.g. a first and second "block" of text) within an application (see e.g. column 1, lines 24-55; and column 4, lines 21-45), wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-45; and FIG. 6). Habib further teaches selecting, in a distinctive manner, a portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portion, as is described above (see e.g. the rejection for claim 4). Moreover, Deike discloses that such teachings can be implemented as program code stored on a computer recordable medium (see e.g. column 6, lines 1-12). Such program code stored on a computer readable medium for implementing the teachings of Deike and Habib is considered a program product like that of claim 21.

Regarding claim 23, Deike describes a set selection system for selecting a first set of data and a second set of data (e.g. a first and second "block" of text) within an application (see e.g. column 1, lines 24-55; and column 4, lines 21-45), wherein the first set of data remains selected during the selection of the second set of data, and wherein the second set of data can be selected anywhere within the application irrespective of a location of the first set of data (see e.g. column 1, line 24 – column 2, line 11; column 4, lines 21-45; and FIG. 6). Habib further teaches a portion selection system for selecting, in a distinctive manner, a portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during selection of the portion, as is described above (see e.g. the rejection for claim 4). The above-described

combination of Deike and Habib thus teach – to one of ordinary skill in the art – a system like that of claim 23, which is for selecting multiple sets of data in an application.

As per claim 24, Habib describes a manipulation system for manipulating (e.g. cutting, copying, pasting, editing) the selected portion (see e.g. column 6, line 24 – column 7, line 7; and FIGS. 4A-4D).

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Deike, which is described above, and also over U.S. Patent No. 5,664,210 to Fleming et al. (hereinafter "Fleming").

As describe above (see e.g. the rejections for claims 1 and 9), Deike teaches a method like that of claims 1 and 9, in which a user can select multiple, non-contiguous sets of data in an application. Deike, however, does not explicitly disclose that the user can de-select a selected set of data, as is expressed in claims 8 and 16.

Like Deike, Fleming describes an application for selecting multiple, non-contiguous sets of data in an application (see e.g. column 1, line 55 – column 2, line 22). Regarding the claimed invention, Fleming further teaches de-selecting a selected set of data (see e.g. column 2, lines 22-29).

It would have been obvious to one of ordinary skill in the art, having the teachings of Deike and Fleming before him at the time the invention was made, to modify the application taught by Deike such that the selected sets of data can be de-selected, like taught by Fleming. It would have been advantageous to one of ordinary skill to allow the user to de-select a selected set of data, because the user would thereby be able to select different combinations of sets of

data, as is taught by Fleming. Deike and Fleming thus teach – to one of ordinary skill in the art – a method like that of claims 8 and 16.

Claims 22 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Deike and Habib, which is described above, and also over the U.S. Patent of Fleming, also described above. As described above (see e.g. the rejections for claims 21 and 23), Deike and Habib teach a program product and system like that of claims 21 and 23, respectively, in which a user can select multiple, non-contiguous sets of data in an application, and can further select multiple portions of a selected set of data. Deike further teaches copying, cutting and pasting the selected sets of data (see e.g. column 1, line 24 – column 2, line 11; and column 4, line 21 – column 5, line 28). Habib also demonstrates manipulating (e.g. cutting, copying, pasting, editing) a selected portion (see e.g. column 6, line 24 – column 7, line 7; and FIGS. 4A-4D). Deike and Habib, however, do not explicitly disclose that the user can de-select a selected set of data or a portion thereof, as is expressed in claims 22 and 25-26.

Nevertheless, like Deike, Fleming describes an application for selecting multiple, non-contiguous sets of data in an application (see e.g. column 1, line 55 – column 2, line 22). Regarding the claimed invention, Fleming further teaches de-selecting a selected set of data (see e.g. column 2, lines 22-29).

It would have been obvious to one of ordinary skill in the art, having the teachings of Deike, Habib, and Fleming before him at the time the invention was made, to modify the application taught by Deike and Habib such that the selected sets of data and portions thereof can be de-selected, like taught by Fleming. It would have been advantageous to one of ordinary skill

to allow the user to de-select a selected set of data, because the user would thereby be able to select different combinations of sets of data, as is taught by Fleming. Deike, Habib, and Fleming thus teach – to one of ordinary skill in the art – a program product and system like that of claims 22 and 25-26.

Conclusion

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. The applicant is required under 37 C.F.R. §1.111(C) to consider these references fully when responding to this action. The U.S. Patent to Torres cited therein describes a method for selecting multiple non-contiguous sets of data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine Basom whose telephone number is (571) 272-4044. The examiner can normally be reached on Monday through Friday, from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

btb
11/09/2007

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SUPERVISORY PATENT EXAMINER